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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,820	11/19/2003	Kishor P. Gadkaree	SP03-157	7195
22928	7590	12/16/2005	EXAMINER	
CORNING INCORPORATED			MARCANTONI, PAUL D	
SP-TI-3-1			ART UNIT	
CORNING, NY 14831			PAPER NUMBER	
			1755	
DATE MAILED: 12/16/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,820

Applicant(s)

GADKAREE ET AL.

Examiner

Paul Marcantoni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 11 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-3,5 and 11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The applicants' 10/12/05 amendment and response is acknowledged but has not been found convincing. The following rejections were necessitated by applicants' amendment.

Non-Election By Original Presentation:

New claim 11 is non-elected by original presentation because it is directed to a *honeycomb* article. This is different than applicants' originally claimed invention which was directed to a cement *composition*. Thus, claim 11 has been withdrawn from consideration because it is a non-elected claim.

35 USC 102 –note: new rejection of art necessitated by amendment

Claims 1-3 and 5 are rejected under 35 USC 102(a and b) as anticipated by Rechter '536, Okubi et al. '518 or '432, Lee et al. '280, Neely Jr '661 B2 or '616 B1, JP 57088084 (abstract), JP 57176109 (abstract), JP 58081419 (abstract), JP 63256576 (Watanabe et al.-abstract), JP 03192176 (Natsui-abstract), GB 2286977 (Lee et al.-abstract), KR 2002058174 (Cho et al.-abstract), or CZ 291443 (Skvara et al.-abstract).

Rechter '536 teaches a composition comprising SiC (col.4, line 49), sodium silicate, and water thus anticipating the claimed invention (see also claims).

Okubi et al. '518 or '432 teach a composition comprising SiC or silicon nitride as the ceramic powder or filler, alkali metal silicate, and water thus anticipating the claimed invention (see claims and in particular, for example, claim 4 in col.20 of '518).

Lee et al. '280 teach a composition comprising calcium aluminate, alkali metal silicate, and water thus anticipating the instant invention (see claims in cols.13-14).

Neely Jr '661 B2 or '616 B1 teach a composition comprising SiC filler (e.g. col.4, line 44 of '616), alkali metal silicate, and water thus anticipating the instant invention.

JP 57088084 teaches a composition comprising SiC, water, and alkali metal silicate thus anticipating the instant invention. (See abstract).

JP 57176109 teaches a composition comprising cordierite, sodium silicate, and water thus anticipating the applicants' claimed invention (see abstract).

JP 58081419 teaches a composition comprising cordierite, alkali silicate, and water thus anticipating applicants' claimed invention (see abstract).

JP 63256576 teaches a composition comprising silicon nitride, sodium silicate, and water thus anticipating applicants' claimed invention (see abstract).

JP 03192176 teaches a composition comprising cordierite, alkali metal silicate, and water thus anticipating applicants' claimed invention (see abstract).

GB 2286977 teaches a composition comprising calcium aluminate, alkali metal silicate, and water thus anticipating the applicants' claimed invention (see abstract).

KR 2002058174 teaches a composition comprising aluminum titanate, alkali metal silicate, and water thus anticipating the claimed invention (see abstract).

CZ 291443 teaches a composition comprising calcium aluminate, water glass (ie which is sodium silicate), and water thus anticipating the applicants' claimed invention (see abstract).

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Response:

Applicants' arguments regarding Satoh and Rochow are now moot as they have been withdrawn because applicants removed alumina as a ceramic powder from their "claimed" invention. Their amendment of claims removing alumina necessitated the new grounds of rejection above. The applicants did argue that these references did not teach the intended use for "plugging ceramic filters or ceramic honeycombs". In rebuttal, the new use of a known composition is not a patentable distinction. The following citation was from MPEP Chapter 2100 to Patentability:

"Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) (Applicant argued that the claimed composition was a pressure sensitive adhesive containing a tacky polymer while the product of the reference was hard and abrasion resistant. "The Board correctly found that the virtual identity of monomers and procedures sufficed to support a *prima facie* case of unpatentability of Spada's polymer latexes for lack of novelty.").

It is also noted that several of the references cited above include a component other than a ceramic powder, alkali metal silicate, and water. Applicants amended their claims to the more closed "consisting essentially of" claim language. However, this term does not necessarily exclude extraneous components unless applicants can show that these extraneous components materially affect their claimed invention. When applicants contends that the modifying components in the reference are excluded by the recitation of "consisting essentially of", applicants have the burden of showing the basic and novel characteristics of their composition – i.e. A showing that the introduction of these

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components would materially change the characteristics of the applicants' composition.

In re Delajarte, 337 F 2d 870, 143 USPQ 256 (CCPA 1964). Thus, absent a showing that the extraneous components materially affect, the applicants' usage of consisting essentially of is not convincing. Applicants' position would have been convincing had they used "consisting of" claim language but they did not. This, it is noted, is not a suggestion but only an observation of the present state of the claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding

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is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
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